

### **REMARKS – General**

#### *Claim Amendments:*

Applicant has amended the independent claims to recite a first client operating in a first system and a second client operating in a second system, where the first system and second system are different. Support for the amendment is found in FIGS. 6-8 and paragraphs [0037], [0046], and [0063], each of which illustrates/describes a different type of system in which a client may operate.

#### *Claim Rejections under 35 USC §102:*

Claims 1-2, 4-9, 24, 28, 31-32, 34-38, 50, 55, 58, 61, 64, 66-73 and 81 are rejected under 35 U.S.C. 102(c) as being anticipated by U.S. Patent Application Publication No. 2006/0271993, App. No. 11/498,388 (published 11/30/2006) by Nakata et al. [hereinafter “Nakata”].

According to MPEP §2131, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). The test is the same for a method or process. Anticipation requires identity between the claimed process and a process of the prior art. The claimed process, including each and every step thereof, must have been described or embodied, either expressly or inherently, in a single reference. *See, e.g., Glaverbel SA v. Northlake Mkt’g & Supp., Inc.*, 45 F.3d 1550 (Fed. Cir. 1995). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by one of ordinary skill in the art to which the invention pertains. *See, e.g., Scripps Clinic & Res. Found. V. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991). “Every element of the claimed invention must literally be present, arranged as in the claim...The identical invention must be shown in as complete detail as is contained in the patent claim.” *See, e.g., Richardson v. Suzuki Motor Company Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

In its response filed October 20, 2010, Applicant noted that the system disclosed by Nakata is expressly tied to the Institute of Electrical and Electronics Engineers (IEEE) standard 1394. As set forth in this standard, which accompanied a previous response, the

standard applies to devices that locally interconnected on a single, wired bus, such as within the home. Exemplary devices used with the 1394 standard include a camcorder, printer, personal computer, or monitor.

As previously presented, Nakata's operation hinges upon this local, wired bus configuration. As emphasized in Nakata at paragraph [0012], "[a]ccording to IEEE 1394...devices are connected in a tree structure in which one device is handled as a root device and then grand child devices connected under the root device." As set forth in Nakata at paragraph [0037], "The AV system comprises an optical disk device 2, and monitor devices 3A and 3B which are connected through a bus specified in IEEE 1394 to form a network." The wired necessity of Nakata is stated time and time again, as shown below (with emphasis added). See, e.g., paragraph [0002], paragraphs [0012]-[0013], paragraph [0018], and paragraphs [0040]-[0041].

The single wired bus configuration of Nakata requires operation within a single system. Any wired bus coupling elements, by definitions set forth in IEEE 1394 and by Nakata's disclosure, creates a single system because all components in the system are expressly tied to the bus, receive the same communication signals as every other device, and are controlled or configured under a single device.

By contrast, Applicant's invention provides advantages over the teachings of Nakata because Applicant's invention is capable of working among different systems, without the requirement of a common bus. Illustrative different systems include the wired system of FIG. 6, the wireless system of FIG. 7, or the interactive broadcast system of FIG. 8. With Applicant's invention as recited in the independent claims, a person watching a television program on in interactive broadcast system through a set-top box can transfer monitoring of the broadcast to a mobile phone operating in a wireless system. To be sure, a set-top box and a mobile phone are not tied to a single communication channel, do not receive all of the same communication signals, and are not configured to be responsive to or "under" a root device. Further, these multi-system devices do not have to vie for communication rights as do IEEE 1394 devices.

Nakata's "single" system and common communication channel requirement not only fails to teach Applicant's multi-system capability, but instead teaches away from multiple systems by requiring a single communication channel through which each

device receives the same communication signals. Applicant's invention enables the transfer of monitoring from one communication system to another, *different system*. Nakata's disclosure is incapable of accomplishing this task. For instance, in Applicant's system, monitoring can be transferred from a cable box, operating on a cable network, to a mobile device operating on a wireless network. By contrast, in Nakata's system, a tree structure is required in which devices all receive the same communication signals. If a device is not connected to the common communication channel, no monitoring transfer can occur.

In the most recent Response to Arguments section, the Examiner acknowledges Applicant's arguments regarding the single communication channel requirement. Additionally, in previous Office Actions, the Examiner has acknowledged the differences that exist between Applicant's system and those, like Nakata's, that are based on IEEE 1394-type architecture. However, the Examiner suggests the differences between Applicant's system and Nakata are not expressly recited in the claims.

In reply, Applicant respectfully submits that its amendment reciting that the first system and second system are different clearly distinguishes its independent claims from Nakata's teachings. This is true because, as noted above, a IEEE 1394-type bus system can only operate within the single system defined by the common communication channel. As noted by the Examiner, the *communication* might not be limited to wire, as suggested by Nakata's paragraph [0112]. However, this makes no difference. Whether communicating across a wire or across a wired connection, Nakata's disclosure still fails to teach Applicant's multi-system claim limitations because Nakata requires operation within a single, closed system. Nakata is incapable of transferring monitoring between clients operating in different systems. Accordingly, Nakata fails to teach "each and every limitation" of applicant's claims as required by MPEP §2131.

To expound on this point for clarity, Nakata states, "The present invention relates to an information signal transmission system and a remote control device for the information signal transmission system and finds applications in a system of video-handling devices that are interconnected *using IEEE* (the Institute of Electrical and Electronics Engineers) *1394*, High Performance Serial Interface Bus Standard (hereinafter simply referred to as IEEE1394)." Nakata, paragraph [0002], emphasis

added. Nakata continues, “According to IEEE 1394, buses are initialized when the devices are connected, and the devices are connected in a tree structure in which one device is handled as a root device with the child and then grand child devices connected under the root device.” Nakata, paragraph [0012], emphasis added. “IEEE1394 allows a signal sent by one device to be relayed to another device so that the same signal is communicated to all devices within a network. More particularly, the network logically work as a buslike manner though it is electrically connected in a point-to-point manner. For this reason, each device has to arbitrate the right to use the bus prior to a start of transmission.” Nakata, paragraph [0113].

Applicant respectfully notes that whether a wired bus or wireless connection is used, Nakata’s single system architecture remains the same. All devices are in a single system because any communication signal is relayed to all devices. Further, one device is the root and all other devices are children under the root. By contrast, Applicants independent claims recite systems that are different. As Nakata fails to teach each and every one of Applicant’s claimed limitations, Applicant respectfully submits the rejection under 35 USC §102 is overcome.

Claims 2, 409, 24, 28, 32, 34-38, 50, 55, 58, 61, and 66-73 are all dependent claims, depending from their respective independent claims 1, 31, 62, 64, and 81. Applicant respectfully requests reconsideration of the §102 rejection to these claims in light of the comments above.

*Claim Rejections under 35 USC §103:*

Claims 3, 33 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakata in view of U.S. Patent Application Publication No. 2002/0049679, App. No. 09/827,469 (published 04/25/2002) by Russell et al. [hereinafter “Russell”].

Claims 10-23, 25-27, 29-30, 39-49, 51-54, 56-57, 59-60, 62-63, 74-80, 82-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakata in view of U.S. Patent Application Publication No. 2005/0028207, App. No. 10/925,826 (published 02/03/2005) by Finseth et al. [hereinafter “Finseth”].

Applicant has shown above that, Nakata fails to teach transferring a monitoring license from a first client to a second client, wherein the systems in which those clients operate is different.

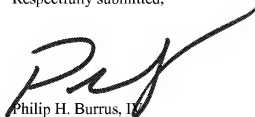
Regarding claims 3, 33, and 65, the addition of Russell fails to remedy this deficiency. Russell teaches only the transfer of a digital rights management key from one device to another. This device, as set forth by Russell at paragraph [0067] provides a secure environment for locally stored, licensed content to be executed. When combined with Nakata, the combination fails to teach the transfer of monitoring from one client to another, where those clients operate in different networks, because the combination requires the single system architecture of Nakata. It is not clear under the disclosed circumstances how the transfer of a digital rights management certificate between devices coupled to a common IEEE 1394-type bus would be beneficial, or how doing so would achieve Applicant's invention without disrupting the desired operation of the common IEEE 1394-type system existing in the primary reference. As such, the alleged motivation is suspect, as it does not appear relevant given the context of the primary reference. This is in addition to the failure to fully support and or describe either one or both of the reference make known or obvious each and every feature of claim 1, as noted above. Further, the combination teaches away from Applicant's invention in that Nakata teaches non-transfer of control. For these reasons, Applicant respectfully requests reconsideration of the rejection to claims 3, 33, and 65.

Regarding claims 10-23, 25-27, 29-30, 39-49, 51-54, 56-57, 59-60, independent claim 62, claims 63, 74-80, 82-86, Applicant respectfully submits that the addition of Finseth to Nakata also fails to remedy the deficiencies set forth above. The combination of Finseth and Nakata both fails to teach and teaches away from Applicant's invention as does the combination of Russell and Nakata. For these reasons, Applicant respectfully requests reconsideration of the rejections to these claims.

**CONCLUSION**

For the above reasons, Applicant believes the specification and claims are now in proper form, and that the claims all define patentably over the prior art. Applicant believes this application is now in condition for allowance, for which it respectfully submits.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Philip H. Burrus, II". The signature is stylized with a large, sweeping initial "P" and a long, horizontal stroke extending to the right.

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